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**FACSIMILE TRANSMITTAL SHEET**

TO:	FAX NUMBER:
Examiner: A. Freistein USPTO Mailstop: Amendment	(571) 273-8300
FROM:	PHONE NUMBER:
Palaiyur S. Kalyanaraman	(908) 298-5068
TOTAL NO. OF PAGES INCLUDING COVER	DATE
14	October 3, 2005

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NOTES/COMMENTS:

**PLEASE HAND DELIVER**In re Application of: **T. Guzi et al.**For Patent entitled: **"17- $\beta$ -Hydroxysteroid Dehydrogenase Type 3 Inhibitors for the Treatment of Androgen Dependent Diseases"**

Group Art Unit: 1626

Filed: 12/15/2003

Attorney Docket No.: OC06001-01

Serial No.: 10/735,983

Dear Examiner Fricstein,

Transmitted herewith are:

- Fax Cover Sheet – 1pg.
- Response Transmittal – 1pg.
- Response/Amendment – 12pgs.

  
 Palaiyur S. Kalyanaraman  
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## Express Mail Label:

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FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number	10/735983
Filing Date	12/15/2003
First Named Inventor	GUZI, Timothy J.
Art Unit	1626
Examiner Name	A. Frestein
Total Number of Pages in This Submission	14
Attorney Docket Number	OC06001-01

## ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
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<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Reply to Missing Parts/ Incomplete Application	<input type="checkbox"/> Landscape Table on CD	
<input type="checkbox"/> <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53		
Remarks		

Fax Cover Sheet - 1pg.

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Customer No: 24265		
Signature			
Printed name	PALAIYUR S. KALYANARAMAN		
Date	10/03/2005	Reg. No.	34,634

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Signature	
Typed or printed name	PALAIYUR S. KALYANARAMAN
Date	10/03/2005

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OCT 03 2005

PATENT: OC06001-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	:	X
T. Guzi et al.	:	Examiner: A. Freistein
Serial No.: 10/735,983	:	Group Art Unit: 1626
Filed: December 15, 2003	:	
For: "17- $\beta$ -Hydroxysteroid Dehydrogenase Type 3 Inhibitors For The Treatment of Androgen Dependent Diseases"	:	

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
Mailstop: Amendment

RESPONSE/AMENDMENT

Sir:

This communication is in response to the Official Action dated September 19, 2005, on the subject patent application. This communication is being faxed to the Examiner's attention at 571-273-8300.

Claims 1-41 are pending in the case. The Examiner restricted the invention into two groups:

Group I: Claims 1-25 and 39-41 drawn to products of formula (I); and  
Group II: Claims 26-38

If electing from among Groups I-II, the Examiner additionally required the election of a single disclosed species for prosecution on the merits.

Applicants believe that all claims 1-41 form part of one and the same invention. Applicants further believe that when there is a linking claim (claim 1 here) encompassing the scope of all the processes, uses, composition and compounds, it is inappropriate to restrict the invention into these various inventions. Applicants also believe that due to such commonality, a complete examination of claims 1-41 as filed would not cause undue burden. Applicants

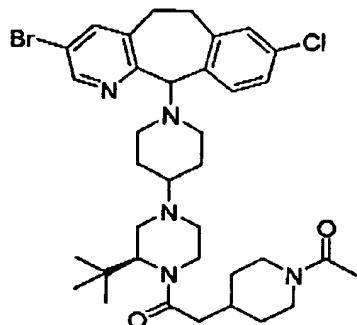
- 2 -

Under the statute "two or more independent and distinct inventions.... in one application may.... be restricted to one of the inventions." Inventions are "Independent" if "there is no disclosed relationship between two or more subjects disclosed" (MPEP 802.01). The term "distinct" means that "two or more subjects as disclosed are related.... but are capable of separate manufacture, use or sale as claimed, and are patentable over each other" (MPEP 802.01). However, even when patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

In the present application, Applicant believes that the Examiner has not established a clear reason to establish the existence of any of the above 3 groups. Reconsideration and withdrawal of the restriction requirement are, therefore, respectfully requested.

During A telephone conversation with the examiner on September 9, 2005, the undersigned attorney-of-record elected, with traverse, the invention cited as Group I for prosecution on the merits, and elected the following species:



again with traverse. (*The Office Action indicates the elected species with a mistake on page 9, with an -NH on the bottom ring of the elected compound instead of -N-C(O)CH<sub>3</sub>. Appropriate correction is respectfully requested.* Additionally, the Office Action indicates the scope of the elected species with a mistake on page 11, omitting an alkyl group between G and R at the bottom;

- 3 -

*(see the elected compound's structure above. Appropriate correction is respectfully requested here too.)* This Response affirms that election (as corrected above). Applicants also agree with the scope of the elected invention as narrated by the Examiner on page 11 of the Office Action with the correction noted above.

Applicants respectfully request entry of the following Amendment made in accordance with the election.

**Amendments to the Claims** are reflected in the listing of claims which begins on page 4 of this paper.

**Remarks** begin on page 12 of this paper.